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Dated: April 6, 2006 Signature: (Lynn L. Janulis)

Docket No.: 30773/6223ND1US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: David E. Lowery *et al.*

Application No.: 10/650,467 Art Unit: 1649

Filed: August 28, 2003 Examiner: John D. Ulm

For: G-Protein-Coupled Receptor-Like Receptors and Modulators Thereof

ELECTION WITH TRAVERSE IN RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement imposed in the Office Action mailed March 6, 2006 (the "Office Action"), the applicants hereby elect Group III (drawn to an isolated polynucleotide encoding a receptor protein, and a vector and host cell comprising that polynucleotide), with traverse, for prosecution on the merits at this time. This election is timely filed.

There would be no serious search burden on the examiner if Groups I-III were examined simultaneously. M.P.E.P. §803 provides:

> If the search and examination of an application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. *(Emphasis added.)*

Thus, for a restriction to be proper, the examiner must satisfy the following two criteria: (1) that independent and distinct inventions are being claimed (35 U.S.C. §121); and (2) that the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. §803.

The examiner asserted that the methods of Group I can be practiced with materially different products, either a cell naturally expressing the recited protein, a recombinant cell expressing that protein, or an isolated protein preparation and, therefore, Groups II and III are each related to Group I as products and process of use. Office Action at page 2. However, the examiner has not shown how the products of Groups II and III would be materially different from a naturally expressed protein or a cell naturally expressing the recited protein. Thus, the examiner has not established a *prima facie* case in support of the restriction requirement between Group I and Groups II and III.

Further, the examiner asserted that the inventions are distinct because the methods of Group I are materially different from the polypeptides of Group II, which can be employed to detect related polynucleotides in a sample, and the isolated protein of Group III can be employed as an immunogen for the production of antibodies thereto. Office Action at page 2. However, the examiner has mischaracterized invention III as being drawn to an isolated protein, which can be employed as an immunogen for the production of antibodies thereto. By doing so, the examiner has failed to establish a *prima facie* case in support of restriction between Groups II and III because the examiner has failed to establish how the claimed products of Group III are different from the products of Group II.

Moreover, the examiner has not established that a serious burden would be imposed on the Patent Office if all claims under consideration were searched and examined together. The claims under consideration define subject matter that directly or indirectly relates to biomolecules of defined sequences, which are searched using electronic databases and do not primarily rely on the classifications identified in the Office Action. The results of these searches contribute to the shape of the examination. The claims of Groups I-III are structurally related by the polynucleotides of SEQ ID NOS: 104 and 106 (Group III) and their encoded polypeptides of SEQ ID NOS: 105 and 107 (Group II). Any search designed to identify art relevant to the patentability of the claimed polypeptides of Group II (claim 68) would also uncover art relevant to the methods of Group I (claims 56-67) and the polynucleotides, vectors, and host cells of Group III (claims 69-76). The applicants respectfully submit that the methods of Group I all involve the polynucleotides of SEQ ID NOS: 104 and 106 of Group III and, therefore, there would be no serious burden on the examiner to search these methods as they relate to the polynucleotides of SEQ ID NOS: 104 and 106.

In light of the above comments and in view of the subject matters of the claims under consideration, the applicants submit that the examiner has failed to establish 1) a *prima facie* case in support of the restriction requirement between Group I and Groups II and III, and between Groups II and III; and 2) that a serious burden would be imposed if all of these claims were searched and examined in the instant application. Accordingly, the applicants submit that the restriction requirement has been overcome and should be withdrawn.

CONCLUSION

For the foregoing reasons, the applicants request reconsideration and withdrawal of the restriction requirement. Should the examiner have any questions or comments regarding this response or the application, the examiner is invited to contact the undersigned at the number indicated.

Dated: April 6, 2006

Respectfully submitted,

By 

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